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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,876	08/18/2006	Jordi Tormo i Blasco	5000-0192PUS1	2828
2292 7590 03/03/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/589,876

**Applicant(s)**

BLASCO ET AL.

**Examiner**

JEFFREY H. MURRAY

**Art Unit**

1624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 9/26/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This action is in response to an election from a restriction requirement filed on December 21, 2007. Election was made **with** traverse in the reply filed on December 21, 2007. There are ten claims pending and six claims under consideration. Claims 6, 7, 9, and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. This is the first action on the merits. The application concerns 5, 6-dialkyl-7-amino-triazolo-pyrimidines, method for producing them, their use for controlling parasitic fungi and agents containing the same.

2. The applicants argue that Gohda, et. al., Quantitative Structure-Activity Relationships (2001), 20(2), 143-147 does not break the unity of invention requirement. Claim 1 of the current application shows a compound where the defined core is a 7-amino-triazolopyrimidine.  $R^1$  and  $R^2$  are varying residues. Gohda et. al., shows a 7-amino-triazolopyrimidine with a 4-chlorophenyl in the 6-position. The current application also teaches a 7-amino-triazolopyrimidine with alkyl derivatives for the  $R^1$  and  $R^2$  groups. Since the replacement of a phenyl with an alkyl group does not alter the activity of the triazolopyrimidine as a fungicidal agent, (of which applicants have numerous patents and applications to 6-aryltriazolopyrimidines) there is no special technical feature at this point. Applicants have failed to show a "special technical feature" of their own compounds and compositions in comparison to the prior art, thus there is no "unity of invention" of the claims. This argument is not found persuasive.

Secondly, applicants request that Group I should be rejoined with Group III. Group III covers the claim involving a "seed". The groups should not be examined together because as just explained previously, there is no special technical feature of the compound or composition of formula I. Claim 9 is not so linked as to form a single inventive concept. The claim is so diverse in scope and requires a separate search and raises different issues of patentability. In this instance, one of the groups is directed towards "a seed." A seed is a composition which is not "closely related" to the compound of Claim 1.

Thirdly, the applicants argue that Group I should be recombined with Group IV. If there was "unity of invention" within this application, this would be a valid argument, however as just stated above, there "unity of invention" has been broken and therefore, the grouping of these claims is proper. This argument is also not found persuasive.

Finally, applicants traverse the request for a species election. Examiner would like to inform applicants that a request for a species election is merely used as a "starting point" for the examiner in his search. If the species is deemed allowable other species within the claims will be searched, until the entire claim is covered, not just the lone species elected. Therefore, this argument is not found persuasive.

Applicants have asked that a possible rejoinder occur with the process claims of the current application. Examiner acknowledges that if compound or composition claims are found allowable during the examination process, a method claim and a

Art Unit: 1624

process claim will be rejoined. The restriction requirement is deemed proper and therefore made **FINAL**.

### ***Priority***

3. This application is a non-provisional application 10/589,876, filed on August 18, 2006, is a national stage application of PCT/EP05/02426, filed on March 8, 2005, and claims foreign priority to German Application No. 102004012018.8, filed on March 10, 2004.

### ***Specification***

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

Art Unit: 1624

- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any of the errors of which applicant may become aware of in the specification.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup>***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2-4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 2-4 and 8 recite the limitation "The compound of the Formula I..." in the first line of the claims. Claim 1 recites, "A triazolopyrimidine of the Formula I...". There is insufficient antecedent basis for this limitation in the claim. Examiner recommends changing Claim 1 to read, "A compound of the Formula I..." Appropriate correction is necessary.

***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 1624

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-5 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of *Blasco, et. al.*, U.S. Patent Publication No. 2007/0179061. Although the conflicting claims are not

identical, they are not patentably distinct from each other because Claim 1 of U.S.

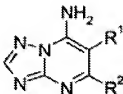
Patent Publication No. 2007/0179061 embraces the instant claims 1-5 and 8.

The instant claims differ from the copending claim by containing a more limited genus than the claim of the copending application. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus of the copending application, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus of the copending application since such compounds would have been suggested by the claims of the copending application. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

11. Claims 1-5 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Publication No. 2007/0173408 in view of *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).

In this application there is the presence of a triazolopyrimidine compound with the general formula I:





where R<sup>1</sup> can be C<sub>5</sub>-C<sub>9</sub> alkyl or C<sub>3</sub>-C<sub>10</sub>-alkoxyethylene and R<sup>2</sup> can be *n*-propyl or *n*-butyl.

The patent publication reference teaches a group of compounds which are similar in scope to the current application. Within Blasco, et. al. almost identical triazolopyrimidine analogs are prepared. These compounds are identical to the current application but for one term. The prior patent publication limits R<sub>2</sub> to an ethyl group. The purpose is to find alternate active triazolopyrimidines which act as fungicidal compounds and compositions. Blasco et. al. has an identical core structure to the current patent application and also teaches triazolopyrimidines for use as fungicides.

The reference teaches compounds where R<sup>1</sup> can be C<sub>5</sub>-C<sub>12</sub> alkyl or C<sub>5</sub>-C<sub>14</sub>-alkoxyalkyl and R<sup>2</sup> can be ethyl, see page 1, paragraph [0002]–[0005]. The reference teaches the pharmaceutical therapeutic use of the compound. Therefore, the instantly claimed compounds differ from the reference compounds by a -CH<sub>2</sub> group and it is well established that compounds that differ by a -CH<sub>2</sub> group are structural homologs. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the reference compounds to prepare the structural homolog. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally

Art Unit: 1624

homologous to prior art compounds are *prima facie* obvious, absent a showing of unexpected results. *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

### ***Conclusion***

19. Claims 1-5 and 8 are rejected.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Patent Examiner  
Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner  
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